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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,291	01/17/2002	Heidi Stuhlmann	A31200-A - 070165.0467	7117

7590 09/22/2003

BAKER BOTTS L.L.P.
44TH FLOOR
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-0228

EXAMINER

WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,291

Applicant(s)

STUHLMANN ET AL.

Examiner

Michael C. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 7-25 have been canceled. Claims 1-6 are pending and under consideration.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: the oath/declaration does not claim benefit to 09/089290.

This application discloses and claims only subject matter disclosed in prior Application No. 09/089290, filed May 22, 1998, and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Oath/Declaration

The declaration is defective because it does not claim priority under USC 120 to parent application 09/089290. Stating US application 10/053291 was filed on May 22, 1998 as US application 09/089290 (1st page of declaration) is not a proper claim for priority to '290. The section for claiming benefit of an earlier US application under 120 in the declaration of the instant application is blank.

A handwritten signature in black ink, consisting of several overlapping loops and a final vertical stroke, located in the bottom right corner of the page.

Specification

- I. The disclosure is objected to because of the following informalities:

This application is a continuation of 09/089290, not a CPA as in the first line of the specification. Correction of the first line is required.

Applicants are required to fill in the blanks in the specification indicating the ATCC Accession Nos. on page 15. In order to make such an amendment, there must be support in the specification for the ATCC Nos. If such support is not present in the specification, applicants are required to submit a declaration stating that they have maintained control and possession of the vector of the ATCC Accession Nos. since the filing date. Otherwise any request to so amend the specification will constitute new matter.

Claim Rejections - 35 USC § 101

- II. 35 U.S.C. 101 reads as follows:

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The specification states the DB1 gene is expressed in human blood cells and adult organs, but the function of the DB1 protein is unknown (page 6, paragraph 3). The specification states the Vezf1 gene is 98% homologous with the DB1

gene and is expressed during vasculogenesis and angiogenesis (pages 41 and 42). The specification does not provide a function for the Vezf1 or DB1 proteins. It is not clear that the homology between Vezf1 and DB1 is sufficient to give the protein products the same activity. The specification does not compare the homologies of Vezf1 or DB1 proteins with any protein with a known function such that the function of Vezf1 or DB1 could be determined with any certainty. While the DNA claimed in the instant invention may be used to make protein or to test for gene expression, such a use is not of value if the function of the protein is unknown. Without a readily apparent utility for the protein, it is unclear that the purified and isolated Vezf1 gene (claim 1), the purified and isolated nucleic acid encoding the Vezf1 protein (claim 3) or the expression vector containing the DB1 gene (claim 6) have any utility. The Vezf1 gene and the DB1 gene do not have a known function in the instant invention and consequently do not have a readily apparent utility.

The claims are free of the art because at the time of filing the Vezf1 gene and protein were not taught or suggested in the art. Nor does the art suggest combining the DB1 gene with a promoter that is selectively active in vascular endothelial cells.

Conclusion

This is a continuation of applicant's earlier Application No. 09/089290. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had

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been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

No claim is allowed.

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-0120.

Questions of formal matters can be directed to the patent analyst, Dianiece Jacobs, who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-3388.

Questions of a general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

If attempts to reach the examiner, patent analyst or Group receptionist are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

The official fax number for this Group is (703) 308-4242.

Michael C. Wilson



MICHAEL WILSON
PRIMARY EXAMINER